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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,351	07/08/2003	Masaya Higuchi	JP920020086US1	8902

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EXAMINER
CHOU, ALAN S

ART UNIT	PAPER NUMBER
2151	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/19/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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PTOL-90A (Rev. 10/06)

Office Action Summary	Application No.	Applicant(s)
	10/615,351	HIGUCHI ET AL.
	Examiner	**Art Unit**
	Alan S. Chou	2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>08 July 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-13* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-13* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>12/21/2005</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claims 1-13 are presented for examination.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

    form the basis for the rejections under this section made in this Office action:

    A person shall be entitled to a patent unless –

    (e) the invention was described in (1) an application for patent, published under section 122(b), by
    another filed in the United States before the invention by the applicant for patent or (2) a patent
    granted on an application for patent by another filed in the United States before the invention by the
    applicant for patent, except that an international application filed under the treaty defined in section
    351(a) shall have the effects for purposes of this subsection of an application filed in the United States
    only if the international application designated the United States and was published under Article 21(2)
    of such treaty in the English language.

2. Claims 1-7, 9-13 are rejected under 35 U.S.C. 102(e) as being anticipated by

    Powlette U.S. Patent Application Publication Number 2006/0143200.

3. As per claim 1, Powlette discloses a client server system comprising: a client

    comprising a WEB browser for browsing a WEB page (see client internet browser

    on page 2 section [0009]); a server connected to the client via a network (see

    remote server on page 2 section [0016]), wherein the client comprises client

    means for transmitting printing information corresponding to an image displayed

    in the WEB browser to the server by using a program operating on the WEB

    browser (see data capture program on page 2 section [0017]); the server further

    comprising printing data means for preparing the data for printing based on the

    received printing information (see modifying data from remote server on page 3

    section [0032]-[0034]); and server means for transmitting the data for printing

prepared by the means for preparatiing the data for printing to the client (see

return modified data file to local system on page 3 section [0036]).

4. As per claim 2, <u>Powlette</u> discloses the client server system according to claim 1,

wherein a plurality of clients having different operating systems or WEB browser

software are connected to the server via the network (see different file system on

page 2 section [0014]).

5. As per claim 3, <u>Powlette</u> discloses the client server system according to claim 1,

wherein the printing information includes information on the image displayed in

the WEB browser and/or information on a source of text displayed in the WEB

browser (see visual image data on page 2 section [0016]).

6. As per claim 4, <u>Powlette</u> discloses the client server system according to claim 1,

wherein the printing information includes additional information displayed or non-

displayed in the WEB browser (see modification to the initial data on page 2

section [0024]).

7. As per claims 5 and 11, <u>Powlette</u> discloses a client comprising: means for

judging whether or not there has been a printing instruction with respect to an

image displayed in a WEB browser using a program operating on the WEB

browser (see data capture program on page 2 section [0016]); means for

preparing printing information based on the printing instruction, when the means

for judging determines that there has been a printing instruction (see data

capture program on page 2 section [0016]); means for transmitting printing

information prepared by the means for preparing printing information to a server

via a network (see file transfer to remote server on page 2 section [0016]); client

means for receiving data for printing prepared by the server based on the printing

information transmitted by the client transmission means from the server via the

network (see save and print modified files on page 3 section [0053]); and output

means for outputting the data for printing received by the client reception means

(see printer on page 3 section [0053]).

8. As per claim 6, Powlette discloses the client according to claim 5, wherein the

program operating on the WEB browser is a Java applet downloaded via the

network (see Java applet on page 2 section [0017]).

9. As per claims 7 and 12, Powlette discloses a server comprising: server means

for receiving printing information on an image prepared by a program operating

on a WEB browser of a client (see receiving modified data file to remote server

on page 2 section [0022]); client means for preparing data for printing based on

printing information received by the server means for receiving (see data

capturing program encoding images on page 2 section [0016]); and server

means for transmitting the data for printing prepared by the client means for

preparing the data (see transferring modified data to client on page 3 section [0052]).

10. As per claims 9, <u>Powlette</u> discloses the server according to claim 7, further comprising: means for storing form data prepared by the means for preparing the data for printing (see storing on local file system on page 3 section [0053]); and means for preparing image data of the data for printing (see send to printer on page 3 section [0053]).

11. As per claims 10 and 13, <u>Powlette</u> discloses a computer apparatus comprising: means for transmitting a program module for preparing printing information based on an image displayed in a WEB browser of a client to the client (see Java applet on page 2 section [0017]); and means for preparing data for printing based on printing information prepared using the program module and transmitted from the client (see modification on the initial data on page 2 section [0024]).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Powlette as applied to claim 7 above, and further in view of Lloyd et al. U.S. Patent Number 6,779,178 B1 (hereinafter Lloyd).

14. As per claim 8, Powlette does not disclose expressly the data for printing is a portable document format (PDF) file. Lloyd teaches the use of PDF files for transferring printer independent documents over the Internet (see column 12 line 40-45). Powlette abd Lloyd are analogous art because they are from the same field of endeavor, remote modification of data files. At the time of the invention it would have been obvious to a person of ordinary skill in the art to use PDF file as one of the formats to save the data for printing. The motivation for doing so would have been to use a printer independent document format that the defacto standard for the Internet. Therefore, it would have been obvious to combine Powlette's remote file printing system with Lloyd's PDF format for printing data to obtain the invention as specified in claim 8.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) System and Method for Permitting a Software Routing Having Restricted Local

Access to Utilize Remote Resources to Generate Locally Usable Data Structure

by <u>Powlette</u>, U.S. Patent Number 6,489,954 B1.

b) System and Method for Annotating & Capturing Chart Data by <u>Powlette</u>, U.S.

Patent Application Publication Number 2002/0018077 A1.

c) Web Print System with Image Enhancement by <u>Ichikawa et al.</u>, U.S. Patent

Number 6,914,694 B1.

d) Method and System to Print via Email by <u>Treptow et al.</u>, U.S. Patent Number

6,993,562 B2.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Alan S. Chou whose telephone number is (571) 272-

5779. The examiner can normally be reached on 7am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Zarni Maung can be reached on (571)272-3939. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

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Business Center (EBC) at 866-217-9197 (toll-free).

AC

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PRIMARY EXAMINER
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